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PATENT

Attorney Docket No.: A-68104/RMS/JJD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Joseph FISHER, et al.

Serial No.: 09/293,670

Filing Date: April 16, 1999

For: MULTIPARAMETER FACS
ASSAYS TO DETECT
ALTERATIONS IN CELLULAR
PARAMETERS AND TO SCREEN
SMALL MOLECULE LIBRARIES

Examiner: T. WESSENDORF

Group Art Unit: 1618

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, DC 20231 on March 5, 2001.

Signed: _____

Todd V. Leone

SECOND RESPONSE AFTER FINAL

Assistant Commissioner
for Patents
Washington, DC 20231

Sir:

This is in response to the Advisory Action mailed January 30, 2001. It is submitted within two months of filing a Notice of Appeal and is therefore, timely filed. While Applicants believe that no fees are due at this time, the Commissioner is authorized to charge any, fees including extension fees or other relief, which may be

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required or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. A-68104/RMS/JJD).

Objection to Finality of Office Action

The Office Action contains new rejections which were not necessitated by Applicants amendments. Specifically, Claims 1-7 were previously rejected under 35 U.S.C. § 102(a) over Nolan, WO 97/27212 (Nolan). The same rejection in the current Office Action encompasses Claim 1-4, 7-10 and 13-14. It is not clear how Applicants amendment, particularly of Claims 8-10, which were only amended (directly or indirectly) as to dependence, no new independent claims were added, and amendments to the independent claims only served to clarify the claims and did not broaden them. The new rejection of at least Claims 8-10 and 14 (which depends from Claim 8) finds no basis in the Applicants' amendment.

Similarly, Claim 3 was previously rejected under 35 U.S.C. § 102(e) over Kamb, USPN 5,955,275 (Kamb). The same rejection in the current Office Action encompasses Claims 3, 8, 10 and 14. As discussed above, the claims were not broadened.

In addition, Claims 5-6 were previously rejected under 35 U.S.C. § 103(a) over Nolan or Kamb in view of Hide et al., *J. Cell Biol.* 123(30:585-593 (1993) (Hide). The same rejection in the present Office Action encompasses Claims 5-6 and 11-12. Claims 11 and 12, added in the response to the previous Office Action, depend (directly or indirectly) from Claim 4, not Claim 5 or Claim 6.

The Advisory Action states that "the finality of the Office Action is proper since the rejections of the claims made in the previous Office Action were simply reiterated and maintained." Applicants submit that this statement is not correct, because the rejections of the previous Office Action were not "simply reiterated and maintained" but new rejections of at least Claims 8-10 and 14 under 35 U.S.C. § 102(a), Claims 8, 10 and 14 under 35 U.S.C. § 102(e) and Claims 11 and 12 under 35 U.S.C. § 103(a) have been

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added to the rejection. None of these rejections were necessitated by Applicants' amendments.

Applicants submit that the rejection of Claims 8-10 and 14 under 35 U.S.C. § 102(a), Claims 8, 10 and 14 under 35 U.S.C. § 102(e) and Claims 11 and 12 under 35 U.S.C. § 103(a) constitute new grounds for rejection. Therefore, the finality of the Office Action mailed July 5, 2000 was premature. Applicants respectfully request withdrawal of finality, entry of the submitted amendments and further examination on the merits of this case.

A Petition to the Commissioner under 37 C.F.R. § 1.181 is being filed concurrent to the present response to review the prematurity of finality in the Office Action mailed July 5, 2000.

If after review of this response, the Examiner believes there are unresolved issues which may be resolved by telephone, the Examiner is respectfully requested to contact the undersigned at (415) 781-1989.

Respectfully submitted,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP

Dated: March 5, 2001

By

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